



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

AGENSYS C/O MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

MAILED

FEB 24 2009

OFFICE OF PETITIONS

In re Application :
Aya Jacobovits et al. :
Application No. 09/771,312 : DECISION ON APPLICATION
Filed: January 26, 2001 : FOR PATENT TERM ADJUSTMENT
Attorney Docket No. 511582000100 :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705 filed December 15, 2008. Applicant requests that the determination of patent term adjustment be increased by 692 days from 606 days to 1298 days. This request is based in part on the Office taking in excess of three years to issue the patent.

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is ordinarily required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). It is noted that at the time of this decision, the patent has not issued.

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

With respect to the over 3 year calculation, rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is GRANTED.

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is six hundred nineteen (**619**) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On September 15, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 606 days. The instant application for patent term adjustment was timely filed¹ on or before payment of the issue fee.

With respect to the patent term adjustment at the time of the mailing of the notice of allowance, applicants acknowledge the period of adjustment of 813 days for Office delay and the periods of reduction of 14, 87, 36, 70 and 9 days for applicant delay (in association with the responses filed March 21, 2008, August 7, 2007, November 3, 2006, October 13, 2005 and March 24, 2005).

Applicants dispute the entry of a period of reduction of 61 days for applicant's response to the Notice to File Missing Parts mailed January 10, 2002. Applicants argue that the response was filed May 28, 2002 and calculate Applicant delay at 48 days, but the Office incorrectly indicates the response was filed June 10, 2002 and incorrectly calculates 61 days of applicants' delay. Applicants assert that the correct number of days of delay is 48 in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b). Thirteen (13) days are at issue.

The reduction of 61 days has been found to be incorrect. A review of the application file reveals that, as stated by applicants, their response to the Notice to File Missing Parts of Application mailed January 10, 2002, is of record in the application with a date of receipt by the Office of May 28, 2002. Furthermore, the response, an executed declaration pursuant to 37 CFR 1.63 and fee for late filing, substitute specification and two month extension of time request constituted a complete reply to the Notice. Thus, the Office should not have entered the date that the instant application was complete as June 10, 2002 or assessed applicants a delay of sixty-one (61) days. The period of reduction of 61 days is being removed and a period of reduction of forty-eight (48) days is being entered.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is six hundred nineteen (619) days.

¹ PALM records indicate that the issue fee was paid on December 15, 2008.


Applicants also note that a Supplemental Information Disclosure Statement was filed on November 10, 2008 and that the Patent Term Adjustment should be reduced by an additional 120 days of applicants' delay, in accordance with 37 CFR 1.704(c)(10).

As acknowledged by applicants, this disclosure is premature. The revised patent term adjustment indicated on the patent will include any periods of reduction (or adjustment) accrued after the mailing of the notice of allowance on September 15, 2008.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PALM Screen

Day : Thursday
Date: 2/12/2009

PALM INTRANET

Time: 18:30:12

| PTA Calculations for Application: 09/771312 | | | |
|---|------------|-------------------------|-----|
| Application Filing Date: | 01/26/2001 | PTO Delay (PTO): | 883 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 277 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 619 |
| PTO Delay Adjustment: | 13 | | |

| File Contents History | | | | | |
|-----------------------|------------|---|-----|------|-------|
| Number | Date | Contents Description | PTO | APPL | START |
| 146 | 02/09/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 48 | |
| 145 | 02/09/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | 61 | | |
| 110 | 09/15/2008 | MAIL NOTICE OF ALLOWANCE | 70 | | 90 |
| 109 | 09/12/2008 | ISSUE REVISION COMPLETED | | | |
| 108 | 09/12/2008 | DOCUMENT VERIFICATION | | | |
| 107 | 09/12/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 106 | 09/12/2008 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 105 | 09/12/2008 | NOTICE OF ALLOWABILITY | | | |
| 104 | 03/21/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 100 | 07/13/2008 | DATE FORWARDED TO EXAMINER | | | |
| 99 | 06/18/2008 | APPEAL BRIEF FILED | | | |
| 98 | 06/18/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 97 | 06/18/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 96 | 06/26/2008 | FILING RECEIPT - CORRECTED | | | |
| 95 | 03/21/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 14 | 90 |
| 94 | 03/21/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 93 | 03/18/2008 | NOTICE -- DEFECTIVE APPEAL BRIEF | | | |
| 92 | 03/14/2008 | APPEAL BRIEF REVIEW COMPLETE | | | |
| 91 | 03/14/2008 | DATE FORWARDED TO EXAMINER | | | |
| 90.1 | 03/07/2008 | DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED | | | |
| 90 | 03/07/2008 | APPEAL BRIEF FILED | | | |

| | | | | | |
|------|------------|---|--|----|----|
| 89 | 03/07/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 88 | 09/06/2007 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 87 | 09/04/2007 | ADVISORY ACTION (PTOL-303) | | | |
| 86 | 08/09/2007 | DATE FORWARDED TO EXAMINER | | | |
| 85 | 08/07/2007 | AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL | | | |
| 84 | 08/07/2007 | NOTICE OF APPEAL FILED | | 87 | 80 |
| 83 | 08/07/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 82 | 11/03/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 81 | 11/03/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 80 | 02/12/2007 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 79 | 02/05/2007 | FINAL REJECTION | | | |
| 78 | 11/27/2006 | DATE FORWARDED TO EXAMINER | | | |
| 77 | 11/03/2006 | RCE- AF PROCESSED | | | |
| 76 | 11/27/2006 | DATE FORWARDED TO EXAMINER | | | |
| 75 | 11/03/2006 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 36 | 67 |
| 74 | 11/27/2006 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 73 | 11/03/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 72 | 11/03/2006 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 71 | 10/31/2006 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 70 | 10/27/2006 | ADVISORY ACTION (PTOL-303) | | | |
| 69 | 10/10/2006 | DATE FORWARDED TO EXAMINER | | | |
| 68 | 09/28/2006 | AMENDMENT AFTER FINAL REJECTION | | | |
| 67 | 06/28/2006 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 66 | 06/26/2006 | FINAL REJECTION | | | |
| 65 | 04/08/2002 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 64 | 02/10/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 63 | 04/14/2006 | DATE FORWARDED TO EXAMINER | | | |
| 62 | 04/07/2006 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 61.7 | 02/10/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| | | | | | |

| | | | | | |
|------|------------|---|-----|----|----|
| 61 | 02/10/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 60.7 | 04/08/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 60 | 04/08/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 59 | 12/18/2001 | PRELIMINARY AMENDMENT | | | |
| 58 | 01/13/2006 | MAIL NON-FINAL REJECTION | | | |
| 57 | 01/09/2006 | NON-FINAL REJECTION | | | |
| 56 | 10/25/2005 | DATE FORWARDED TO EXAMINER | | | |
| 55 | 10/13/2005 | RESPONSE AFTER NON-FINAL ACTION | | 70 | 53 |
| 54 | 10/13/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 53 | 05/04/2005 | MAIL NON-FINAL REJECTION | | | |
| 52 | 05/02/2005 | NON-FINAL REJECTION | | | |
| 51 | 03/29/2005 | DATE FORWARDED TO EXAMINER | | | |
| 50 | 03/24/2005 | RESPONSE TO ELECTION / RESTRICTION FILED | | 9 | 48 |
| 49 | 03/24/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 48 | 12/15/2004 | MAIL RESTRICTION REQUIREMENT | | | |
| 47 | 12/13/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 46 | 12/03/2004 | MAIL NOTICE OF RESCINDED ABANDONMENT | | | |
| 45 | 12/03/2004 | NOTICE OF RESCINDED ABANDONMENT IN TCS | | | |
| 44 | 08/17/2004 | MAIL-PETITION TO REVIVE APPLICATION - GRANTED | | | |
| 43 | 07/21/2004 | PETITION ENTERED | | | |
| 42 | 06/16/2004 | MAIL EXPRESS ABANDONMENT (DURING EXAMINATION) | 813 | | -1 |
| 41 | 06/14/2004 | EXPRESS ABANDONMENT (DURING EXAMINATION) | | | |
| 40 | 06/03/2004 | LETTER OF EXPRESS ABANDONMENT FILED | | | |
| 39 | 06/03/2004 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 38 | 05/11/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 37 | 04/22/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 36.7 | 02/28/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 36 | 02/28/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |

| | | | | | |
|----|------------|--|--|----|----|
| 35 | 04/14/2004 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 34 | 03/23/2004 | APPLICATION RETURN FROM OIPE | | | |
| 33 | 03/23/2004 | APPLICATION IS NOW COMPLETE | | | |
| 32 | 03/23/2004 | PRE-EXAM OFFICE ACTION WITHDRAWN | | | |
| 31 | 03/23/2004 | APPLICATION RETURN TO OIPE | | | |
| 30 | 03/19/2004 | APPLICATION RETURN FROM OIPE | | | |
| 29 | 03/19/2004 | APPLICATION IS NOW COMPLETE | | | |
| 28 | 08/15/2003 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 26 | 12/18/2002 | ADDITIONAL APPLICATION FILING FEES | | | |
| 25 | 12/18/2002 | A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN | | | |
| 24 | 10/10/2002 | SEQUENCE ERRORS | | | |
| 23 | 10/10/2002 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 22 | 10/10/2002 | SEQUENCE ERRORS | | | |
| 21 | 06/10/2002 | A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN | | 61 | 10 |
| 20 | 06/25/2002 | PRE-EXAM OFFICE ACTION WITHDRAWN | | | |
| 19 | 10/10/2002 | APPLICATION RETURN TO OIPE | | | |
| 18 | 10/01/2002 | APPLICATION MADE UNAVAILABLE FOR EXAMINATION | | | |
| 17 | 09/12/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 16 | 07/24/2002 | APPLICATION DISPATCHED FROM OIPE | | | |
| 15 | 06/25/2002 | APPLICATION IS NOW COMPLETE | | | |
| 13 | 05/28/2002 | ADDITIONAL APPLICATION FILING FEES | | | |
| 12 | 05/28/2002 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 11 | 05/28/2002 | APPLICANT HAS SUBMITTED A NEW SPECIFICATION TO CORRECT CORRECTED PAPERS PROBLEMS | | | |
| 10 | 01/10/2002 | NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED | | | |
| 6 | 12/26/2001 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 5 | 05/16/2001 | XXXXX | | | |
| 4 | 05/16/2001 | MISCELLANEOUS INCOMING LETTER | | | |
| 3 | 04/18/2001 | MISCELLANEOUS OFFICE ACTION MAILED | | | |
| 2 | 02/17/2001 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| | | | | | |

Search Another: Application#

Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to [OASIS](#) | Home page